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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,450

06/19/2006

Johan Willy Declerck

DECL3001/JEK

9009

23364 7590 09/03/2008

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EXAMINER

ZACHARIA, RAMSEY E

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,450	<b>Applicant(s)</b> DECLERCK, JOHAN WILLY	
	<b>Examiner</b> Ramsey Zacharia	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102***

2. Claims 1-6, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 63-224944 A.

This action relies upon the English language translation provided by the applicant.

JP 63-224944 A teach a multilayer film formed by co-extrusion comprising an ethylene-ethyl acrylate-maleic anhydride layer bonded to a polychlorotrifluoroethylene layer by ethylene-glycidyl methacrylate-vinyl acetate polymer (abstract). The ethylene-ethyl acrylate-maleic anhydride layer corresponds to the polyolefin layer of the instant claims. The ethylene-glycidyl methacrylate-vinyl acetate polymer corresponds to the jointing layer of the instant claims. In the embodiment of the example, the polychlorotrifluoroethylene layer has a thickness of 150  $\mu\text{m}$ .

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsai (US 6,306,503).

Tsai teaches a multilayer film comprising a fluoropolymer layer attached to a thermoplastic layer by means of an intermediate adhesive layer (column 2, lines 20-26). Preferably, the fluoropolymer is a homopolymer or copolymer of chlorotrifluoroethylene (column 2, lines 34-37). Preferably, the thermoplastic layer comprises a polyolefin (column 2,

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lines 52-53). The fluoropolymer layer may have a thickness of up to 10 mils, i.e.  $\sim 250 \mu\text{m}$  (column 4, lines 9-10). The multilayer film may be formed in any conventional manner including coextrusion and lamination (column 3, lines 58-64).

### ***Claim Rejections - 35 USC § 103***

4. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (US 6,306,503) in view of Annegret (EP 1,287,909).

Tsai teaches all the limitations of claims 7-12, as outlined above, except for the specific details of the extrusion/lamination process. However, Tsai does teach that the multilayer film may be prepared in any convention manner (column 3, lines 58-64).

Annegret is directed to a method for forming coatings and laminations (paragraph 0001). Figures 2-10 illustrate various embodiments for adhering first and second substrates with a hot melt adhesive wherein the adhesive is extruded and the laminate is compressed between first and second rollers (paragraph 0030). The adhesive may be extruded on a first layer to form a two layer on one of the rollers before passing through the nip between the rollers (e.g. Figures 2 and 3). Alternatively, the adhesive may be extruded between the rollers guiding the first and second layers through to the nip (Figure 4). The rollers may be heated (paragraph 0033) and at least one roller typically comprises rubber (paragraph 0031). The method of Annegret avoids streaking and striation problems and allows the lamination to be carried out inline or offline (paragraphs 0006-0007).

One skilled in the art would be motivated to use the method of Annegret to form the multilayer film of Tsai to yield a product that does not suffer from streaking and striation

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problems and to take advantage of the ability to operate inline and/or offline as needed, particularly since Tsai explicitly teaches the multilayer film may be prepared in any conventional manner.

With respect to claim 8, it would be within the ability of one skilled in the art to extruded the adhesive onto either of the layers, including the polyolefin layer, since the adhesive adheres to both layers (otherwise it would not keep the laminate together) and both layers are compressed together through the same nip. Thus, one skilled in the art would be expected to have an equal expectation of success regardless onto which layer the adhesive was extruded.

With respect to claims 10-12, since either roller may be designated an "the first roller" or "the second roller," the fact that at least one roller is heated and at least one roller typically comprises rubber is sufficient to satisfy the limitations of these claims.

### ***Response to Arguments***

5. Applicant's arguments filed 09 June 2008 have been fully considered but they are not persuasive.

With respect to the rejection over JP 63-224944 A, the applicant argues three differences between the claimed invention and the reference. First, the claimed invention recites a layer of polyolefin in general while JP 63-224944 A recites a particular ethylene polymer. Second, the claimed invention recites a jointing layer in general while JP 63-224944 A recites a particular ethylene methacrylate copolymer. Finally, the applicant argues the claimed film is manufactured by extrusion lamination rather than co-extrusion.

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This is not persuasive for the following reasons. Regarding the first and second points raised by the applicant, it is noted that even one particular species (e.g. a copolymer of both ethylene and glycidyl methacrylate) is sufficient to anticipate a broader genus (e.g. jointing layer). Regarding the third argument, it is noted that the limitation directed to the film being extrusion laminated is a product-by-process type limitation. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and MPEP § 2113. In this case, although JP 63-224944 A uses coextrusion rather than extrusion lamination, the resulting *product* anticipate the structural limitations of the claimed film. Thus, the burden is on the applicant to conclusively demonstrate that the claimed process by which the product is formed results in a materially different product. This burden is not met merely by noting that the products were formed using different methods.

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With respect to the rejection over Tsai, the applicant argues that the process used to form the film of Tsai (i.e. any convention technique) is different that extrusion lamination which is not a convention technique for forming multilayer films. The applicant also argues that the jointing layer of the instant claims is not required to comprise a styrene-containing rubber as required by Tsai.

This is not persuasive for the following reasons. Regarding the argument directed to the process by which the claimed film is formed, it is again noted that, as a product-by-process limitation, the burden is on the applicant to conclusively demonstrate that the claimed process by which the product is formed results in a materially different product. Moreover, as shown by the Annegret reference that was published before the filing of the instant application, extrusion lamination is a known technique for forming multilayer films, belying the applicant's contention that extrusion lamination is not a conventional technique. Regarding the argument directed to the styrene-containing rubber required by Tsai, it is again noted that even one particular species (e.g. a styrene-containing rubber) is sufficient to anticipate a broader genus (e.g. jointing layer).

With respect to the rejection over Tsai in view of Annegret, the applicant surmise that one skilled in the art would not directly be stimulated to apply extrusion lamination but rather look for different compositions of the adhesive layer in order to obtain better adhesive qualities. It is argued that nowhere in Annegret is it disclosed that altering the manufacturing parameters would lead to improved adhesion, but rather that Annegret aims to avoid streaking and striations. Finally, it is argued that altering said parameters would require much trail and error and require a research process to find the optimal manufacturing parameters.

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This is not persuasive for the following reasons. That Annegret do not teach that their method results in better adhesion is irrelevant since there are other factors that would motivate one skilled in the art to use the process of Annegret to form the film of Tsai - i.e. to yield a product that does not suffer from streaking and striation problems and to take advantage of the ability to operate inline and/or offline as needed. It has been held that it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See MPEP 2144. Since there is sufficient motivation to combine the references (i.e. to yield a product that does not suffer from streaking and striation problems and to take advantage of the ability to operate inline and/or offline as needed) and a reasonable expectation of success (since Tsai explicitly teaches the multilayer film may be prepared in any conventional manner), the rejection is maintained even though the motivation for employing an extrusion lamination process may be different from that of the applicant. Regarding the argument that altering the parameters of the manufacturing process would require a research process involving trial and error to find the optimal manufacturing parameters, it is noted that Annegret teaches all the process limitations recited in the claims. Moreover, it would be within the ability of one skilled in the art to apply routine experimentation to arrive at optimal or suitable operating parameters, since the experimentation needed to determining appropriate operating parameters of a disclosed prior art process would be no more than the application of the expected skill of a polymer engineer/scientist.



***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached at (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ramsey Zacharia/

Primary Examiner, Art Unit 1794